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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,089	09/26/2000	Thomas Liebeke	P00,1722	3824

26574 7590 05/28/2004

SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, IL 60606-6473

EXAMINER

TRINH, MINH N

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,089

Applicant(s)

MELF ET AL. 

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9-13 is/are pending in the application.
4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 2 is/are rejected.
7) ☒ Claim(s) 3-5 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed in 3/16/2004 has been fully considered and made of record. However, newly submitted claims 9-13 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: that Inventions original claimed (claims 1-5) and newly submitted claims 9-13 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not required to have a single component restraining element mounted on the component displacement apparatus, etc., as required by the subcombination. The subcombination has separate utility such as it has utility by itself such as the component restraining element adapted for preventing the component in the removal position from being dislodged from the component holding location, etc. (see claim 9, lines 10-12).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soth (US 5,020,959).

Soth teaches the supply module of the present comprising: a component displacing apparatus 12 in wherein the components are displaced in an advancing direction along advancing plane to a removal position from which the component are removed by the component head of the automatic component mounting machine 22 (see Figures 1-2, in which Figure 1, shows a displacing apparatus 12 including a number of associated features thereof, and Figure 2, shows a mounting machine 22 associated with in, see Abstract, lines 1-11), said component displacement 12 defining a removal opening at a removal side through which the component mounting head removes the component; an adjustable locking element 28 that at least partially blocks an electrical component at the removal opening (see Figure 1, open area under 28) when the adjustable locking element 28 is in a blocking position and that releases the electrical component 15 at the removal opening when the adjustable locking element is in a removal position (see illustration present in Figure 4, see col. 3); the adjustable locking element 28 including a strip 30 extending in the advancing direction, the strip 30 having a width of less than a lateral distance between the electrical component 15 at the removal opening and an adjacent exterior side of the component displacing apparatus 12 (see Figure 2), the adjacent exterior side extending in the advancing direction

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perpendicular to the advancing plane 45, the adjustable locking element 28 (see Figs 1-4, col. 3, lines 10-68 and col. 4). Soth does not teach the adjustable element being electrically actuated to selectively move transversally in the direction into an edge region between the electrical component at the removal position and the exterior side. However, regarding the feature as noted above, it would have been an obvious matter of design choice to choose electrical or mechanical to actuate the locking member since applicant has not disclosed that the adjusting able locking element being electrically actuated is critical, patentably distinguishing feature and it appears that the invention would perform equally well with the mechanical adjustable element 28 as shown in the prior art reference (see Figs. 1-4, and the discussion in col. 3-4 of Soth). Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the electrically actuated adjustable locking member in replace of the mechanical locking member, since it has been held that broadly providing an electrical or automatic means to replace manual or mechanical activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Response to Arguments

4. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

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5. Claims 3-5 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reasons for the indication of allowable subject matter: That the prior art does not teach the limitations of " wherein said narrow finger is a single freely projecting bending spring 7 having a non free end (left hand) and being anchored by said non free end on a fixed bearing 8 of the component displacement apparatus 2 as set forth in claims 3-5.

Interviews After Final

6. Applicants note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing). Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied. See MPEP 714.13 and 713.09.

Conclusion

7. Please provide numeral references to the claimed limitations as well as support in the disclosure (i.e., page and line numbers and reference number associated with from the drawings) for better clarity. Applicant requires to point out the support for any

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amendment made to the disclosure and the claims. See 37CFR 1.111 and section 2163.06 of the MPEP.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to read 'Minh Trinh', followed by a horizontal line.

Minh Trinh
Patent Examiner Group 3729

mt
May 26, 2004